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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,537	09/23/2003	Don Warburton	14374.106	2130

7590 08/19/2005

ERIC L. MASCHOFF  
WORKMAN, NYDEGGER & SEELEY  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111

EXAMINER

XU, LING X

ART UNIT PAPER NUMBER

1775

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/668,537	Applicant(s) WARBURTON, DON	
	Examiner Ling X. Xu	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The specification stand objected because the use of the trademarks "HPC/H02" and "HPC/H05" has been noted in this application and the generic terminology of the material known by the trademark stated above was not provided in the specification.

The terms "high emissivity coating" and "passivating thermal barrier coating" are not the generic terminology of "HPC/H02" and "HPC/H05". The generic terminology of the trade name should be the generic name (not type) of the material of "HPC/H02" and "HPC/H05", for example, TEFLON is a insulation material, however, the generic name for TEFLON is polytetrafluoroethylene not insulation material.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed emissive coating which substantially comprising an inorganically bonded ceramic was not described sufficiently in the specification to enable one skilled in the art to make and use the invention.

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The only example of the coating material is referred to trade names on paragraphs [0054]-[0055], which the generic terminology was not provided. The Examiner has searched the manufacturer's internet website and did not find the cited product information.

Applicant is required to provide the generic name of coating material of "HPC/H02" and "HPC/H05" in order to enable one skilled in the art to make and use the invention. The terms "high emissivity coating" and "passivating thermal barrier coating" are not the generic terminology of "HPC/H02" and "HPC/H05".

***Claim Rejections - 35 USC § 102/103***

3. Claims 1-2, 4-15 and 17-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McManus (US 3,400,882) for the reasons of record set forth in the Office action dated 2/4/2005.

4. Claims 1-2 and 4-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bliesner (6,329,098) for the reasons of record set forth in the Office action dated 2/4/2005.

5. Claims 3, 16 and 20-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McManus, as applied to claims 1-2, 4-15 and 17-19 above, and further in view of Tormey et al. (US 5,725,808) for the reasons of record set forth in the Office action dated 2/4/2005.

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6. Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bliesner, as applied to claims 1-2 above, and further in view of Tormey et al. (US 5,725,808) for the reasons of record set forth in the Office action dated 2/4/2005.

***Response to Arguments***

7. Applicant's arguments filed 7/18/2005 have been fully considered but they are not persuasive.

With respect to the rejection under 35 USC 112, first Paragraph, applicant argues that applicant has provided two specific examples of suitable emissive coatings and identified the name and address of the manufacturer of these coatings.

As stated above, the only two examples of the coating materials are "HPC/H02" and "HPC/H05", which the generic terminology was not provided. The Examiner has searched the manufacturer's internet website and did not find the cited product information.

As also stated above, the terms "high emissivity coating" and "passivating thermal barrier coating" are not the generic terminology of "HPC/H02" and "HPC/H05". The generic terminology of the trade name should be the generic name of the material of "HPC/H02" and "HPC/H05".

Applicant is required to provide the generic name of coating material of "HPC/H02" and "HPC/H05" in order to enable one skilled in the art to make and use the invention.

Applicant also argues that the specification has provided extensive detail in the specification regarding particular characteristics and properties of the emissive coatings.

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The particular characteristics and properties of the emissive coatings indicated by the application still do not provide sufficient information about what the coating materials are since there is no evidence on the record to show that other materials which is not used as emissive coatings would not have these characteristics and properties as well.

Applicant also argues that the Examiner has cited no authority to support the proposition that an example of an exemplary product listed in a specification much be described on the manufacturer's website, nor has the Examiner any authority in support of the proposition that a lack of description on the manufacturer's website is a defect that must be overcome or remedied by the applicant.

Applicant has misunderstood the Examiner's statement regarding the search of the website of the manufacturer. Examiner has tried to make a further attempt to find out the generic terminology of the coating material of "HPC/H02" and "HPC/H05".

Since the Examiner has exhausted all the possible resources available, Applicant is required to provide the generic name of coating material of "HPC/H02" and "HPC/H05" in order to enable one skilled in the art to make and use the invention. Applicant may submit a copy of the manufacture menu containing information of the coating materials of "HPC/H02" and "HPC/H05" to overcome the rejection under 35 USC 112(1) if the information is sufficient for one skill in the art to understand the generic name of the coating materials.

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With respect to the rejections based on the prior arts cited in the prior Office action, Applicant's arguments can be summarized as that the prior arts alone and in combination do not teach the coating substantially comprising an inorganically bonded ceramic.

As stated in the prior Office action, both cited references, McManus and Bliesner, disclose the use of ceramic coating. The term "ceramic" is defined in Hawley's Condensed Chemical Dictionary, 13<sup>th</sup> Edition, p 231, as "a product, in which silicon and its oxide and complex compound known as silicates occupy a predominant position." The components of ceramic material such as silicon, silicon oxide and silicates are all inorganic compounds. Therefore, a ceramic is considered to be an inorganically bonded material.

Further, with respect to claims 3, 16 and 20-26, applicant also argues that the prior arts do not disclose "an inorganically bonded ceramic having an oxide filler".

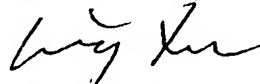
As stated in the prior Office action, Tormey teaches the oxide filler to the ceramic which is used to coat on the metal substrate can reduced shrinkage and have a low firing temperature (col. 2, lines 45-60). Therefore, it would have been obvious to one of ordinary skill in the art to add oxide filler to the ceramic coating of McManus/Bliesner in order to improve the properties of the ceramic coating such as reduced shrinkage and have a low firing temperature.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ling X. Xu  
Examiner  
Art Unit 1775